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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,837	08/27/2003	Jason Edward Gibson	200309117-1	7413

22879 7590 09/18/2008

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EXAMINER

PARK, CHAN S

ART UNIT	PAPER NUMBER
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2625

NOTIFICATION DATE	DELIVERY MODE
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09/18/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/650,837	Applicant(s) GIBSON, JASON EDWARD	
	Examiner CHAN S. PARK	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/27/03 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's Appeal Brief was received on 7/1/08, and has been entered and made of record. Currently, **claims 1-45** are pending.

Response to Arguments

2. In view of the appeal brief filed on 3/15/05, PROSECUTION IS HEREBY REOPENED.

New grounds of rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the network server and Internet server storing said database (Claims 10, 11, 38 and 39) and the step/means for requiring authentication to access said database (Claims 12 and 40) must be shown or the feature(s) canceled from the claim(s). Furthermore, the step of modifying printing device settings and the additional step of configuring said printing device (Claims 1 & 2) must be shown or the feature(s) canceled from the claim(s). Furthermore, the step of obtaining configuration settings (claim 44) and the additional step of obtaining configuration settings (claim 45) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

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Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claims are objected to because of the following informalities:

Claim 25, line 2, “query a database” should be -- query said database --;

Claim 29, line 5, “based said identifier” should be -- based on said identifier --;

and

Claim 32, line 2, “a print job” should be -- said print job --.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2, 16, 17, 19-23, 26, 32, 42, 43 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites a limitation of “configuring said printing device according to said settings”. It appears that this step of configuring is processed after or before the step of modifying printing device settings recited in claim 1. It is unclear if the claimed method is modifying printing device settings and configuring the printing device setting again

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later. Are the obtained settings recited in claim 2 same as the printing device settings recited in claim 1? Clarification/explanation from the Specification is requested.

Claims 19 and 21-23 recite limitations of said printing device comprising a database wherein said database is stored in a memory of said print device/server/web server. It is extremely confusing as to whether this database is a physical unit of said printing device. If so, how can a physical unit be stored in a memory of a physical printer? Or is the database simply a set of data? If so, how can said printing device comprise a set of data? Clarification/explanation from the Specification is requested.

Furthermore, claims 22 and 23 recites the limitations of storing the database on a server. However, claim 19 already indicates that the database is a part of the said printer. It is unclear how this database, which is a part of the printer, be stored on a network server. Does the printer comprise a network server, too?

Clarification/explanation from the Specification is requested.

Claim 26 recites the limitations “said data packet” and “said identification information”. There is insufficient antecedent basis for these limitations in the claim.

Claim 32 recites the limitation “said printing device function”. There is insufficient antecedent basis for the limitation in the claim.

Claim 45 recites the limitation of obtaining "configuration settings associated with said location". It is noted that claim 44 also recites the step of obtaining configuration settings. It is unclear if said instruction causes said printing device to obtain the settings twice based on the same identifier. If so, which configurations setting does the printer

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use to configure printer settings? Is it the setting obtained in claim 44 or claim 45?

Clarification/explanation from the Specification is requested.

MPEP 2173.03 recites,

Although the terms of a claim may appear to be definite, inconsistency with the specification disclosure or prior art teachings may make an otherwise definite claim take on an unreasonable degree of uncertainty. In re Cohn, 438 F.2d 989, 169 USPQ 95 (CCPA 1971); In re Hammack, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970). In Cohn, the claim was directed to a process of treating a surface with a corroding solution until the metallic appearance is supplanted by an “opaque” appearance. Noting that no claim may be read apart from and independent of the supporting disclosure on which it is based, the court found that the description, definitions and examples set forth in the specification relating to the appearance of the surface after treatment were inherently inconsistent and rendered the claim indefinite.

Claims 16 and 17 recite a limitation of “determining a group to which said printing device belongs based on said identifier”. However, referring to the Specification (corresponding Paragraph [0039]), it determines a group to which the sender belongs based on the identifier. The source IP address does not determine a group to which said printing device belongs since the database only associates the IP address with the group to which the sender belongs. Note that these claims appear to be read apart from the supporting disclosure on which it is based. Clarification/explanation from the Specification is requested.

Claim 20 recites a limitation of “a database associating identifiers with printing device locations and printing device locations with printing device configuration settings”. However, referring to the Specification (corresponding Paragraph [0039]), the source IP address (the identifier) is only associated with the physical locations of the

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senders, not the printing device. It is unclear from the Specification why said printing device stores a plurality of printing device locations. Again, the claim appears to be read apart from the supporting disclosure on which it is based. Clarification/explanation from the Specification is requested.

With respect to claims 42 and 43, arguments analogous to those presented for claims 16 and 17, are applicable.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-7, 9, 12, 15, 18, 19, 21, 24, 28-35, 37, 40, 41 and 44 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Edwards et al. U.S. Patent Application Pub. No. 2004/0212834 (hereinafter Edwards).

With respect to claim 1, Edwards teaches a method of configuring a printing device, said method comprising dynamically modifying printing device settings based on an identifier in an incoming print job identifying a client submitting said print job (paragraph 42).

With respect to claim 2, Edwards teaches the method of claim 1, further comprising:

scanning data packets of said print job for said identifier (paragraph 64);
querying a database to obtain settings for said printing device associated with said identifier (paragraph 52); and
configuring said printing device according to said settings associated with said identifier (paragraph 42).

With respect to claim 3, Edwards teaches the method of claim 2, wherein said querying a database comprises:

determining a location associated with said identifier (the location of media selection parameter in the mapping module associated with the IP address must be determined in order to retrieve the parameter from the data); and
retrieving settings for said printing device associated with said location (paragraph 42).

With respect to claim 4, Edwards teaches the method of claim 2, wherein said configuring said printing device occurs automatically when a print job is received (S408 in fig. 4).

With respect to claim 5, Edwards teaches the method of claim 2, wherein said scanning comprises searching header data for said identifier (paragraph 64).

With respect to claim 6, Edwards teaches the method of claim 2, further comprising storing said identifier in printing device memory (it must be either temporarily or permanently stored in order to make the comparison in paragraph 42).

With respect to claim 7, Edwards teaches the method of claim 2, wherein said database is organized such that each identifier is associated with a set of printing device settings (mapping module storing a plurality of media selection parameters in paragraphs 42).

With respect to claim 9, Edwards teaches the method of claim 2, wherein said database is stored in printing device memory (mapping module 209 in paragraph 42).

With respect to claim 12, Edwards teaches the method of claim 2, further comprising requiring authentication to access said database (logging in to the database in paragraph 53).

With respect to claim 15, Edwards teaches the method of claim 1, wherein said identifier comprises an IP address (paragraph 42).

With respect to claim 18, Edwards discloses a printing device comprising:
an input for receiving a print job (S400 in fig. 4); and
a print engine configured to produce a hardcopy from said print job (print engine 220 in fig. 2);

wherein said printing device extracts an identifier from said print job and adjusts printing device configuration settings based on said identifier (paragraph 42).

With respect to claim 19, Edwards discloses the printing device of claim 18, further comprising a database associating identifier with printing device configuration settings (paragraph 42).

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With respect to claim 21, Edwards discloses the printing device of claim 19, wherein said database is stored in a memory unit of said printing device (mapping module 209 in paragraph 42).

With respect to claim 24, Edwards discloses the printing device of claim 18, further comprising a programmable controller programmed to scan data packet headers for said identifier (paragraph 64).

With respect to claim 28, Edwards discloses the printing device of claim 18, further comprising a user interface (operation panel 21 in fig. 2).

With respect to claim 29, Edwards discloses a system for configuring a printing device, said system comprising:

means for extracting an identifier from an incoming print job identifying a client submitting said print job (extracting source IP address in paragraph 42); and

means for dynamically modifying printing device settings based on said identifier (paragraph 42).

With respect to claim 30, arguments analogous to those presented for claim 2, are applicable.

With respect to claim 31, arguments analogous to those presented for claim 3, are applicable.

With respect to claim 32, arguments analogous to those presented for claim 4, are applicable.

With respect to claim 33, arguments analogous to those presented for claim 5, are applicable.

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With respect to claim 34, arguments analogous to those presented for claim 6, are applicable.

With respect to claim 35, arguments analogous to those presented for claim 7, are applicable.

With respect to claim 37, arguments analogous to those presented for claim 9, are applicable.

With respect to claim 40, arguments analogous to those presented for claim 12, are applicable.

With respect to claim 41, arguments analogous to those presented for claim 13, are applicable.

With respect to claim 44, Edwards discloses a computer readable medium having computer executable instructions thereon which, when executed, cause a printing device to:

scan a print job for an identifier (extracting the source IP address in paragraph 42);

obtain configuration settings associated with said identifier (paragraph 42); and

configure said printing device according to said configuration settings (paragraph 42).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8, 13, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards as applied to claims 1 and 2 above, and further in view of Houri U.S. Patent 6,665,715.

With respect to claim 8, Edwards teaches the method of claim 2, wherein said database is organized such that each identifier is associated with a set of printing device settings (paragraph 42).

Edwards, however, does not explicitly disclose a database storing a client location associated with said identifier.

Houri, the same field of endeavor of the IP address, discloses a database storing a client location associated with corresponding IP address (fig. 1).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the printer of Edwards to include the database for storing a client location associated with corresponding IP address as taught by Houri.

The suggestion/motivation for doing so would have been to inform the printer where the sender is physically located.

Therefore, it would have been obvious to combine Edwards with Houri to obtain the invention as specified in claim 8.

With respect to claim 13, see fig. 1 of Houri for identifying a zone in which the client is physically located.

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With respect to claims 16 and 17, note that the examiner construes a plurality of zones of Houri as a plurality of different groups to which the senders belong.

8. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards as applied to claim 2 above, and further in view of Shima U.S. Patent Application No. 2004/0098471.

With respect to claims 10 and 11, Edwards teaches the method of claim 2, but it does not explicitly teach whether said database is stored on a network server or Internet server.

Shima, the same field of endeavor of setting the printing device based on the setting parameter stored in the database, teaches the method of printing parameters in a database stored in a network/Internet server (paragraphs 70-75 & 86).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the server database for storing the printer parameters into the printing system of Edwards.

The suggestion/motivation for doing so would have been to reduce the cost of internal memory and further provide the printing device with most updated printing device settings associated with the identifier.

Therefore, it would have been obvious to combine Edwards with Shima to obtain the invention as specified in claims 10 and 11.

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9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Edwards and Houri as applied to claim 13 above, and further in view of Masuda U.S. Patent Application Pub. No. 2003/0135597.

With respect to claim 14, the combination discloses the method of claim 13, but it does not explicitly disclose that said physical location comprises a floor number.

Masuda discloses the step of identifying a floor number based on the MAC address (paragraph 31).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the printer of Edwards to include the database for storing a floor number associated with corresponding MAC address as taught by Masuda.

The suggestion/motivation for doing so would have been to inform the printer where the sender is physically located.

Therefore, it would have been obvious to combine three references to obtain the invention as specified in claim 14.

10. Claims 20, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards as applied to claim 18 above, and further in view of Houri.

With respect to claim 20, arguments analogous to those presented for claims 8 and 13, are applicable. IP addresses are associated with the client locations according to Houri.

With respect to claim 25, Houri acquires the physical location information based on the IP address in fig. 1.

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With respect to claim 26, IP addresses are associated with the client locations according to Houri.

11. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards as applied to claim 19 above, and further in view of Shima.

With respect to claims 22 and 23, arguments analogous to those presented for claims 10 and 11, are applicable.

12. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards as applied to claim 18 above, and further in view of Venkatranman et al. U.S. Patent Application No. 2001/0025307 (hereinafter Venkatranman).

With respect to claim 27, Edwards discloses the printing device of claim 18, but it does not explicitly disclose that the printing device comprises an embedded web server.

Venkatranman, the same field of endeavor of the network printing/facsimile device, discloses a printing device having an embedded web server for providing a user with the printing device information on a webpage (fig. 1B & paragraph 27).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate the web server of Venkatranman into the printing device of Edwards.

The suggestion/motivation for doing so would have been to provide the printing device information to a user on the network.

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Therefore, it would have been obvious to combine Edwards with Venkatranman to obtain the invention as specified in claim 27.

13. Claims 36, 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards as applied to claims 29 and 30 above, and further in view of Hourì.

With respect to claim 36, arguments analogous to those presented for claim 8, are applicable.

With respect to claims 42 and 43, arguments analogous to those presented for claims 16 and 17, are applicable.

14. Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards as applied to claim 30 above, and further in view of Shima.

With respect to claims 38 and 39, arguments analogous to those presented for claims 10 and 11, are applicable.

15. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards as applied to claim 44 above, and further in view of Hourì.

With respect to claim 45, arguments analogous to those presented for claim 8, are applicable.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571)272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHAN S PARK/
Examiner, Art Unit 2625

/Edward L. Coles/
Supervisory Patent Examiner, Art Unit 2625

September 12, 2008